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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/037,480	01/04/2002	Gregor Cevc	56822 (47126)	5210

21874 7590 10/16/2003
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BOSTON, MA 02209

EXAMINER

FORTUNA, ANA M

ART UNIT	PAPER NUMBER
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1723

DATE MAILED: 10/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/037,480

Applicant(s)

CEVC ET AL.

Examiner

Ana M Fortuna

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 January 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 35-41, 60, 61, 66-69 and 102 is/are pending in the application.
- 4a) Of the above claim(s) 2 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 35-41, 60-61 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 6-8, 68, 69 and 102 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

Application Number



Application No.

10/037,480

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Examiner

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DETAILED ACTION

Claim Rejections - 35 USC § 112

1. Claims 1-3, 5-9, 35-41, 61, and 66-69, and 102 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "preferably" in claim 1 is repeated two times in the claim, as indicating three possible values of reduction of reduction of elastic energy of the membrane, which renders the claim unclear as to what value is intended. Claims dependent on claim 1 are also considered to be unclear. Claims 61, 66-67 and 102 are also unclear as depending from a cancelled claim. Claims 66 and 65 are depending from claim 65, which has been cancelled, claim 102 depends on claim 66, and is therefore unclear as it should be or not considered as depending on claim 1. In claims 66, 67, and 102, the term "lipid-like" is unclear as to whether "lipid" is intended. Claim 61 is dependent on claim 54, which is cancelled. Accordingly, claims 61, 65, 66, and 102, have not been considered, because they are not clearly directed to the limitations of claim 1. In such a way that they further limit any specific limitation on claim 1.
2. The term "preferably" in claims 1, 3, is a relative term, which renders the claim indefinite. The term "preferably" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

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3. Claims 4, 36, 37, 38, 39, 68, 69, are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only and /or cannot depend from another multiple dependent claims. See MPEP § 608.01(n). Accordingly, claims 4, 68, and 69 have not been further treated on the merits.

3. Claims 35-41, 60 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 35-41 are directed to "a patch comprising the formulation of claim 1. Claims 38-41 depend on claim 35 and are also directed to a patch. The claims do not further limit the patch, because claim 1 is not directed to "formulation", but to a process of controlling the flux of semi-permeable membranes. The claims above have not been treated on the merits.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-2, 5, 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Speaker (Re.33,273)(hereinafter '273). Reference '273 teaches improving the separation properties of a semi-permeable membrane by depositing on the membrane amphiphilic substances, as claimed in the first alternative limitation of claim 1 (abstract, column 3, lines 31-44, column 28, lines 39-46). The solubility of the amphiphilic

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substances is not disclosed, however, fluorinated and nonfluorinated amphiphilic substances are suggested (column 2, lines 18-61), therefore, the solubility of these amphiphilic substances is inherently different. Selecting the amphiphilic substances depending on the intended degree of membrane performance it would have been obvious to one skilled in the art the degree of solubility inherently controls the amount of the substance to be provided in the membrane, and its final hydrophobic or hydrophilic properties. As to claims 2 and 9, increasing the area or the dose per area is suggested in reference '273, e.g. providing multiple treatments or layers of the amphiphilic substance (column 11, lines 34-42).

Allowable Subject Matter

6. Claims 6-8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. Claim 3 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action, and if rewritten in independent form including all the limitations of the base claims and any intervening claim.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ana M Fortuna whose telephone number is (703) 308-3857. The examiner can normally be reached on 9:30-6:00 M-F.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L. Walker can be reached on (703) 308-0457. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Ana M Fortuna
Primary Examiner
Art Unit 1723

AMF